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PATENT APPLICATION

ATTORNEY DOCKET NO. 10007916 -1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Michael J. Lemon

Confirmation No.: 2371

Application No.: 09/884549

Examiner: Ming Hun Liu

Filing Date: Jun 19, 2001

Group Art Unit: 2675

Title: Digital Annotator

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Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 10/27/2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1590.00

() The extension fee has already been filled in this application.

() (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

(X) I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit: 12-27-04

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Number of pages:

Typed Name: **Be Henry**

Signature: Be Henry

Respectfully submitted,

Michael J. Lemon

By Philip Lyren

Philip Lyren

Attorney/Agent for Applicant(s)

Reg. No. **40,709**

Date: **12-27-04**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael J. Lemon

Examiner: Ming Hun Liu

Serial No.: 09/884,549

Group Art Unit: 2675

Filed: June 19, 2001

Docket No.: 10007916-1

Title: Digital Annotator

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is filed in response to the Final Office Action mailed June 28, 2004 and the Notice of Appeal filed on October 27, 2004.

AUTHORIZATION TO DEBIT ACCOUNT

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's deposit account no. 08-2025.

REAL PARTY IN INTEREST

The real party-in-interest is the assignee, Hewlett-Packard Company, a Delaware corporation, having its principal place of business in Palo Alto, California.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences known to appellant, the appellant's legal representative, or assignee that will directly affect or be directly affected by or have a bearing on the Appeal Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-3, 5-15, and 17-20 stand finally rejected. No claims have been allowed. The final rejection of claims 1-3, 5-15, and 17-20 is appealed.

STATUS OF AMENDMENTS

In response to the Final Office Action (date mailed: 06/28/2004), Appellant submitted an After-Final Response (date mailed: 08/12/2004) wherein several claims were amended. In the Advisory (date mailed: 11/04/2004), the Examiner refused to enter the proposed amendments in the After-Final Response.

Appellant does not contest the Examiner's refusal to enter the proposed amendments in the After-Final Response. The Claims Appendix corresponds to the claims as they were pending prior to the After-Final Response.

SUMMARY OF CLAIMED SUBJECT MATTER

The summary is set forth in six exemplary embodiments that correspond to independent claims 1, 5, 8, 11, 15, and 17. Discussions about elements and recitations of these claims can be found at least at the cited locations in the specification and drawings.

Claim 1

A computer annotator system for accessing Internet data addresses, the system comprising:

- an electronic tablet (Figs. 2, #205) having visible marking capability ([0023]);
- a marking stylus (Fig. 2C; #211) associated with the tablet ([0023], [0025]);
- a device (Figs. 2, #203) for associating at least one temporarily marked location (Figs. 2 and 3, #213) on said tablet with a preselected Internet data address (Fig. 2C, #209) wherein subsequently accessing said marked location with said stylus triggers a shift to said data address associated with said marked location ([0023] – [0030]).

Claim 5

A method for indexing computer-accessible Internet sites, the method comprising:

- accessing a first of said sites (Fig. 2B, [0024]);
- associating an address indicative of the first of said sites with a first location coordinate address on a computer writing tablet via a first visible marking a first random location on said writing tablet during access of said first of said sites (Fig. 2C, [0025]);
- accessing a second of said sites (Fig. 2D, [0026]); and
- associating an address indicative of the second of said sites with a second location coordinate address on the computer writing tablet via a second visible marking on a second random location on said writing tablet during access of said second of said sites (Fig. 2E, [0026]).

Claim 8

A method for using a computer writing tablet, the method comprising:

- associating an input-output port of the tablet with signals indicative of Internet-associated computer data addresses ([0023]);
- when each of a plurality of the Internet-associated computer data addresses is accessed ([0024]), writing a mnemonic object associated therewith respectively ([0025]), wherein a location on said tablet of the mnemonic object is coupled to a current one of said Internet-associated computer data addresses ([0027]); and

accessing any specific one of said plurality of the Internet-associated computer data addresses by selecting the mnemonic object associated therewith ([0028] – [0029]).

Claim 11

A computerized method comprising:
accessing an internet site ([0024]); and
associating an address of the site with a writable-erasable mnemonic device in a computer writing tablet such that said site is re-accessible directly from said writable-erasable mnemonic device ([0025] – [0029]).

Claim 15

A computer memory comprising:
computer code for recording temporary symbols (Figs. 2 and 3, #213 and #215) associated with an Internet site address (Fig. 2C, #209; [0024] – [0025]);
computer code associating the internet site address with a writable-erasable mnemonic device in a computer writing tablet (Figs. 2, #205) for receiving said temporary symbols ([0023]); and
computer code for accessing said Internet site address via said temporary symbols ([0028]).

Claim 17

An internet search tool comprising;
an internet access device (Figs. 2, #203; [0023]);
in communication with the internet access device, a writing tablet (Figs. 2, #205) and associated inking stylus (Fig. 2C, #211; [0025]); and
associated with the combination of internet access device, writing tablet and stylus, program code using said tablet for generating bookmarks (Fig. 3, #213, #215; [0026]) thereon related to respective search resultant internet sites such that said sites are accessible directly via said bookmarks ([0028]).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

I. Claims Rejection - 35 USC § 103

Claims 1 and 2 are rejected under 35 USC § 103 as being unpatentable over USPN 6,456,307 (hereinafter Bates).

II. Claims Rejection - 35 USC § 103

Claims 3, 5-15, and 17-20 are rejected under 35 USC § 103 as being unpatentable over Bates in view of USPN 5,592,607 (hereinafter Weber).

ARGUMENT

I. Claims Rejection - 35 USC § 103

Claims 1 and 2 are rejected under 35 USC § 103 as being unpatentable over USPN 6,456,307 (hereinafter Bates). Appellant respectfully contests the rejection of all of these claims. Claim 1 is representative of this group and is argued below.

Overview of Law on § 103

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Appellant asserts that the rejection does not satisfy these criteria.

A. No Suggestion or Motivation to Modify Bates

Bates would have to be significantly modified to teach or suggest the recitations of claim 1. For several reasons, such modification is not proper since no motivation or suggestion exists for this modification.

First, Bates teaches a completely different invention. Bates is directed to a method and system for automatically generating icons on a display screen. The icons visually represent the web page so the user can easily distinguish between multiple icons on the display screen (see Col. 2, lines 16-26).

In contrast to Bates, claim 1 is directed to associating marked locations on a tablet with preselected internet addresses. Claim 1 recites three separate elements: a tablet, a marking stylus, and a device. The device associates a marked location on the tablet with a preselected internet address. When the marked location on the tablet is subsequently accessed with the stylus, a shift occurs to the internet address.

Bates does not even teach the three different elements as recited in claim 1. Bates teaches a mouse as a pointing device and states “other graphical-pointing devices such as a graphic tablet ... could also be used” (Col. 5, lines 26-29). Thus, Bates teaches that the mouse itself could be a graphic tablet. Claim 1, however, recites a pointing device (i.e., a stylus) and a separate tablet. Thus, the pointing device (i.e., the mouse) in Bates would have to be substituted with both a stylus and a tablet. Then, the substituted stylus and tablet would have to perform function as recited in claim 1. Bates provides no suggestion or motivation for such a substitution. In short, new elements and significant substitutions would have to be made to Bates.

Further, even if these three elements (tablet, stylus, and device) were present in Bates, nowhere does Bates teach or suggest that **the device associates a marked location on the tablet with a preselected internet address. When the marked location on the tablet is subsequently accessed with the stylus, a shift occurs to the internet address.**

Second, there is no motivation to modify Bates since Bates is directed to solving an entirely different problem. In the Background, Bates discusses the problem being solved (see Col. 1, line 58 – Col. 2, line 12: text omitted):

Over time, the user may accumulate many icons, which can be small and not easily distinguishable, especially because the images in each browser icon are identical since the icon represents the browser and not the web page (it is only the minimal, associated text that might relate to the web page). In addition to the browser, a user might also have many other windows open or minimized as

icons. This creates additional clutter on the display and causes the user even more difficulty when searching for the desired icon.

Thus, users often spend much time squinting at small icons, trying to remember which icon is associated with which web page or window.

Thus, there is a need for a mechanism that creates icons that are easily distinguishable.

In contrast to Bates, Appellant's Background discusses problems associated with browser book-marking systems. Further discussions are directed to pen-based computer devices (i.e., stylus and tablet) utilizing handwriting recognition. The Background states (see [0007]):

There is a need for a method of using ink writing tablets to facilitate computer search results indexing, adaptable to use with Internet and other computerized functions.

Thus, no suggestion or motivation exists to modify Bates since Bates and the claimed invention are directed to completely different inventions.

For at least these reasons, Appellant respectfully requests withdraw of the rejection of claims 1 and 2.

B. No Reasonable Expectation of Success

No reasonable expectation of success has been established for modifying Bates to arrive at the recitations of claim 1. As noted, even if Bates taught all three elements (tablet, stylus, and device), Bates is completely silent on the interaction of these elements. In other words, nowhere does Bates teach or suggest that **the device associates a marked location on the tablet with a preselected internet address. When the marked location on the tablet is subsequently accessed with the stylus, a shift occurs to the internet address.** In order to arrive at the recitations of claim 1, the principle of operation of Bates would have to be modified, and no basis exists for such modification.

For at least these reasons, Appellant respectfully requests withdraw of the rejection of claims 1 and 2.

C. Bates Not Teach/Suggest All Claim Limitations

Claim 1 recites numerous limitations that are not taught or suggested in Bates. For example, Bates does teach or suggest the three different elements (tablet, stylus, and device) as recited in claim 1. Bates teaches a mouse as a pointing device and states “other graphical-pointing devices such as a graphic tablet ... could also be used” (Col. 5, lines 26-29). Thus, Bates teaches that the mouse itself could be a graphic tablet. Bates, however, is silent on utilizing a separate tablet in conjunction with a stylus.

Further, even if these three elements were present in Bates, nowhere does Bates teach or suggest the recitations associated with these elements. The claim recites that **the device associates a marked location on the tablet with a preselected internet address. When the marked location on the tablet is subsequently accessed with the stylus, a shift occurs to the internet address.**

For at least these reasons, Appellant respectfully requests withdraw of the rejections of claim 1 and 2.

II. Claims Rejection - 35 USC § 103

Claims 3, 5-15, and 17-20 are rejected under 35 USC § 103 as being unpatentable over Bates in view of USPN 5,592,607 (hereinafter Weber).

Appellant respectfully contests the rejection of all of these claims. Further, each of the independent claims (5, 8, 11, 15, and 17) is separately argued below with a separate sub-heading.

Overview of Law on § 103

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Appellant asserts that the rejection does not satisfy these criteria.

Sub-Heading I: Claim 5 not obvious over Bates and Weber

Claim 5 is rejected under 35 U.S.C. §103 as being obvious over Bates and Weber. Appellant asserts that the rejection does not satisfy the criteria of MPEP § 2143.

A. No Suggestion or Motivation to Combine Bates and Weber

For several reasons, no motivation or suggestion exists to combine Bates and Weber. First, Bates and Weber teach completely different inventions. Bates is directed to a method and system for automatically generating icons on a display screen. The icons visually represent the web page so the user can easily distinguish between multiple icons on the display screen (see Col. 2, lines 16-26). In contrast to Bates, Weber is directed to a method and system for providing a note-taking structure that supports a user's natural note-taking processes (see Col. 4, lines 16-31).

Thus, no motivation or suggestion exists to modify or combine Bates with Weber since the references are directed to completely different inventions.

Second, there is no motivation or suggestion to modify or combine Bates with Weber since these references are directed to solving entirely different problems. In the Background, Bates discusses the problem being solved (see Col. 1, line 58 – Col. 2, line 12: text omitted):

Over time, the user may accumulate many icons, which can be small and not easily distinguishable, especially because the images in each browser icon are identical since the icon represents the browser and not the web page (it is only the minimal, associated text that might relate to the web page). In addition to the browser, a user might also have many other windows open or minimized as icons. This creates additional clutter on the display and causes the user even more difficulty when searching for the desired icon.

Thus, users often spend much time squinting at small icons, trying to remember which icon is associated with which web page or window.

Thus, there is a need for a mechanism that creates icons that are easily distinguishable.

Thus, no motivation or suggestion exists to modify or combine Bates with Weber since the references are directed to solving completely different problems.

In contrast to Bates, Weber's Background discusses problems associated with prior note-taking devices. These prior devices require a user to adapt his/her note-taking process and do not provide a flexible interface for a wide variety of different note-takers (see Col. 3, lines 65 - Col. 4, line 6).

For at least these reasons, Appellant respectfully requests withdraw of the rejection of claim 5 and its dependents.

B. Bates and Weber Not Teach/Suggest All Claim Limitations

Claim 5 recites numerous limitations that are not taught or suggested in Bates and Weber. Claim 5 is reproduced below for convenience (emphasis added):

A method for **indexing** computer-accessible **Internet sites**, the method comprising:

accessing a first of said sites;

associating an address indicative of the first of **said sites** with a first location **coordinate address on a computer writing tablet** via a first visible **marking a first random location on said writing tablet** during access of said first of said sites;

accessing a second of said sites; and

associating an address indicative of the second of **said sites** with a second location **coordinate address on the computer writing tablet** via a second visible **marking on a second random location on said writing tablet** during access of said second of said sites.

Appellant submits that at least the emphasized recitations are not taught or suggested in Bates and Weber. For example, claim 5 recites associating an address of an internet site with a location coordinate address on a computer writing tablet. Bates and Weber, alone or in combination, do not teach or suggest this recitation. Bates does not even teach a tablet but, instead, teaches automatically generating icons on a display

screen (see Col. 2, lines 16-26). Weber does teach a device for receiving handwriting. Further, Weber does not teach or suggest that a coordinate address in a tablet is associated with an internet site. In short, neither reference teaches or suggests that the device for receiving handwriting has a coordinate address associated with an internet address.

As another example, claim 5 recites that the first and second visible markings are on a random location on the writing tablet. These limitations, when read in conjunction with the entire claim, are not taught or suggested in Bates and/or Weber. In fact, these references are completely silent in this regard.

Thus, the cited art does not teach or suggest each and every limitation of claim 5. All dependent claims that depend from independent claim 5 inherit all limitations of the base claim. For at least the reasons given in connection with claim 5, the dependent claims are also allowable over Bates and/or Weber.

Sub-Heading II: Claim 8 not obvious over Bates and Weber

Claim 8 is rejected under 35 U.S.C. §103 as being obvious over Bates and Weber. Appellant asserts that the rejection does not satisfy the criteria of MPEP § 2143.

A. No Suggestion or Motivation to Combine Bates and Weber

Appellant repeats the argument proffered in Sub-Heading I part A in claim 5. For at least these reasons, Appellant respectfully requests withdraw of the rejection of claim 8 and its dependents.

B. Bates and Weber Not Teach/Suggest All Claim Limitations

Claim 8 recites numerous limitations that are not taught or suggested in Bates and Weber. Claim 8 is reproduced below for convenience (emphasis added):

A method for using a computer writing tablet, the method comprising:

**associating an input-output port of the tablet with signals indicative of
Internet-associated computer data addresses;**

when each of a plurality of the Internet-associated computer data addresses is accessed, **writing a mnemonic object associated therewith** respectively, wherein a location on said tablet of the mnemonic object is coupled to a current one of said Internet-associated computer data addresses; and
accessing any specific one of said plurality of the Internet-associated computer data addresses by selecting the mnemonic object associated therewith.

Appellant submits that at least the emphasized recitations are not taught or suggested in Bates and Weber. For example, claim 8 recites associating an input-output port of the tablet with signals indicative of Internet-associated computer data addresses. Bates and Weber, alone or in combination, do not teach or suggest this recitation. Bates does not even teach a tablet but, instead, teaches automatically generating icons on a display screen (see Col. 2, lines 16-26). Weber does teach a device for receiving handwriting, but does not teach or suggest an input-output port associated with signals indicative of internet addresses. In short, the references, alone or in combination, do not teach or suggest associating an input-output port of the tablet with signals indicative of Internet-associated computer data addresses.

As another example, claim 8 recites writing a mnemonic object associated with internet addresses. Weber does teach a device for receiving handwriting, but Weber does not teach or suggest writing a mnemonic object associated with an internet address. Further, the combination of Bates and Weber would fail to teach or suggest this recitation.

Thus, the cited art does not teach or suggest each and every limitation of claim 8. All dependent claims that depend from independent claim 8 inherit all limitations of the base claim. For at least the reasons given in connection with claim 8, the dependent claims are also allowable over Bates and/or Weber.

Sub-Heading III: Claim 11 not obvious over Bates and Weber

Claim 11 is rejected under 35 U.S.C. §103 as being obvious over Bates and Weber. Appellant asserts that the rejection does not satisfy the criteria of MPEP § 2143.

A. No Suggestion or Motivation to Combine Bates and Weber

Appellant repeats the argument proffered in Sub-Heading I part A in claim 5. For at least these reasons, Appellant respectfully requests withdraw of the rejection of claim 11 and its dependents.

B. Bates and Weber Not Teach/Suggest All Claim Limitations

Claim 11 recites numerous limitations that are not taught or suggested in Bates and Weber. Claim 11 is reproduced below for convenience (emphasis added):

A computerized method comprising:

accessing an internet site; and

associating an address of the site with a writable-erasable mnemonic device in a computer writing tablet such that said site is re-accessible directly from said writable-erasable mnemonic device.

Appellant submits that at least the emphasized recitations are not taught or suggested in Bates and Weber. For example, claim 11 recites associating an address of the internet site with a writable-erasable mnemonic device in a tablet. Bates and Weber, alone or in combination, do not teach or suggest this recitation. Bates does not even teach a mnemonic device in a tablet but, instead, teaches automatically generating icons on a display screen (see Col. 2, lines 16-26). Weber does teach a device for receiving handwriting, but does not teach or suggest associating an address of an internet site with a writable-erasable mnemonic device. In short, the references, alone or in combination, do not teach or suggest associating an address of an internet site with a writable-erasable mnemonic device in a tablet.

As another example, claim 11 recites that the internet site is **re-accessible directly from said writable-erasable mnemonic device**. The references are completely silent on this claimed recitation. Weber does teach a device for receiving handwriting, but Weber does not teach or suggest associating an internet address with the mnemonic device.

Appellant notes that the Office Action has completely failed to address the claimed recitations in claim 11. Instead, the Final Office Action merely makes a circular statement: "Claim 11 is rejected on the ground outlined in the rejection of claims 3 and 7" (see Final OA at p. 4). Claims 3 and 7, however, do not recite the same limitations that appear in claim 11. Thus, the Examiner has failed to establish a prima facie case of obviousness for claim 11.

Thus, the cited art does not teach or suggest each and every limitation of claim 11. All dependent claims that depend from independent claim 11 inherit all limitations of the base claim. For at least the reasons given in connection with claim 11, the dependent claims are also allowable over Bates and/or Weber.

Sub-Heading IV: Claim 15 not obvious over Bates and Weber

Appellant repeats the argument proffered in Sub-Heading I part A in claim 5. For at least these reasons, Appellant respectfully requests withdraw of the rejection of claim 15 and its dependents.

B. Bates and Weber Not Teach/Suggest All Claim Limitations

Claim 15 recites numerous limitations that are not taught or suggested in Bates and Weber. Claim 15 is reproduced below for convenience (emphasis added):

A computer memory comprising:

- computer code for recording temporary symbols associated with an Internet site address;
- computer code **associating the internet site address with a writable-erasable mnemonic device** in a computer writing tablet for receiving said temporary symbols;
- and
- computer code for accessing said Internet site address via said temporary symbols.

Appellant submits that at least the emphasized recitations are not taught or suggested in Bates and Weber. For example, claim 15 recites computer code that

associates the internet site with a mnemonic device in a computer writing tablet for receiving the temporary symbols. Bates and Weber, alone or in combination, do not teach or suggest this recitation. Bates does not even teach a tablet but, instead, teaches automatically generating icons on a display screen (see Col. 2, lines 16-26). Weber does teach a device for receiving handwriting, but does not teach or suggest associating an internet site address in any way with the device for receiving handwriting. Further, Weber does not teach or suggest receiving temporary symbols associated with an internet site. In short, the references, alone or in combination, do not teach or suggest associating the internet site with a mnemonic device in a computer writing tablet for receiving the temporary symbols.

Further, Appellant notes that the Office Action has completely failed to address the recitations in claim 15. Instead, the Final Office Action merely makes a circular argument: “Claim 15, 17 and 18 are rejected on basis outlined in the rejection of claim 8” (Final OA at p. 4). However, the argument with regard to claim 8 states: “Claim 8 is rejected on basis outlined in the rejection of claims 3, 5 and 6” (Final OA at p. 4). Claims 3, 5, and 6, however, do not recite the same limitations of claim 15. Thus, the Office Action has failed to make a prima facie showing of obviousness for claim 15.

Thus, the cited art does not teach or suggest each and every limitation of claim 15. For at least the reasons, claim 15 is allowable over Bates and/or Weber.

Sub-Heading V: Claim 17 not obvious over Bates and Weber

Appellant repeats the argument proffered in Sub-Heading I part A in claim 5. For at least these reasons, Appellant respectfully requests withdraw of the rejection of claim 17 and its dependents.

B. Bates and Weber Not Teach/Suggest All Claim Limitations

Claim 17 recites numerous limitations that are not taught or suggested in Bates and Weber. Claim 17 is reproduced below for convenience (emphasis added):

An internet search tool comprising;
an internet access device;

in communication with the internet access device, a writing tablet and associated inking stylus; and

associated with the combination of internet access device, writing tablet and stylus, program code using said tablet for generating bookmarks thereon related to respective search resultant internet sites such that said sites are accessible directly via said bookmarks.

Appellant submits that at least the emphasized recitations are not taught or suggested in Bates and Weber. For example, claim 17 recites a tablet for generating bookmarks thereon. Bates and Weber, alone or in combination, do not teach or suggest this recitation. Bates does not even teach a tablet but, instead, teaches automatically generating icons on a display screen (see Col. 2, lines 16-26). Weber does teach a device for receiving handwriting, but does not teach or suggest generating bookmarks on the tablet.

As another example, claim 17 recites the writing tablet and the inking stylus are in communication with the internet access device. These three different elements (tablet, stylus, and internet access device) are not disclosed or suggested in Bates and Weber. Fig. 1 in Bates shows a computer system that is used to implement the invention in Bates (Col. 5, lines 11-15). In Fig. 1, a processing unit 12 connects to a mouse 118, display 114, and keyboard 116 (see Col. 5, lines 12-21). In numerous figures, Weber shows a display screen (see example, Figs. 3, 8, 9). Together, Bates and Weber fail to teach or suggest that a writing tablet and inking stylus are in communication with an internet access device. Further yet, these references have no teaching or suggestion of using the tablet to generate bookmarks. Even further still, claim 17 recites that the internet sites are accessible directly via the bookmarks. Nowhere do Bates and/or Weber teach or suggest these recitations.

Further, Appellant notes that the Office Action has completely failed to address the recitations in claim 17. Instead, the Final Office Action merely makes a circular argument: "Claim 15, 17 and 18 are rejected on basis outlined in the rejection of claim 8" (Final OA at p. 4). However, the argument with regard to claim 8 states: "Claim 8 is rejected on basis outlined in the rejection of claims 3, 5 and 6" (Final OA at p. 4). Claims

3, 5, and 6, however, do not recite the same limitations of claim 17. Thus, the Office Action has failed to make a prima facie showing of obviousness for claim 17.

Thus, the cited art does not teach or suggest each and every limitation of claim 17. All dependent claims that depend from independent claim 17 inherit all limitations of the base claim. For at least the reasons given in connection with claim 17, the dependent claims are also allowable over Bates and/or Weber.

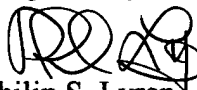
CONCLUSION

In view of the above, Appellant respectfully requests the Board of Appeals to reverse the Examiner's rejection of all pending claims.

Any inquiry regarding this Appeal should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Respectfully submitted,



Philip S. Lyren
Reg. No. 40,709
Ph: 281-514-8236

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 27th day of December, 2004.

By



Name: Be Henry

Claims Appendix

1. A computer annotator system for accessing Internet data addresses, the system comprising:

an electronic tablet having visible marking capability;

a marking stylus associated with the tablet;

a device for associating at least one temporarily marked location on said tablet with a preselected Internet data address wherein subsequently accessing said marked location with said stylus triggers a shift to said data address associated with said marked location.
2. The system as set forth in claim 1 comprising:

said tablet having at least one predetermined first surface region accessible to said stylus wherein annotating function commands are implemented.
3. The system as set forth in claim 2 comprising:

said table having at least one predetermined second surface region accessible to said stylus wherein freehand symbols indicative of the preselected data address are entered.
4. (canceled)
5. A method for indexing computer-accessible Internet sites, the method comprising:

accessing a first of said sites;

associating an address indicative of the first of said sites with a first location coordinate address on a computer writing tablet via a first visible marking a first random location on said writing tablet during access of said first of said sites;

accessing a second of said sites; and

associating an address indicative of the second of said sites with a second location coordinate address on the computer writing tablet via a second visible marking on a second random location on said writing tablet during access of said second of said sites.

6. The method as set forth in claim 5 further comprising:

continuing said method for a plurality of computer-accessible internet sites other than said first and said second as long as there is available space for a further visible marking.

7. A method as set forth in claim 5 comprising:

erasing a said visible marking on said writing tablet after a last access to an associated address indicative of a computer-accessible internet site.

8. A method for using a computer writing tablet, the method comprising:

associating an input-output port of the tablet with signals indicative of Internet-associated computer data addresses;

when each of a plurality of the Internet-associated computer data addresses is accessed, writing a mnemonic object associated therewith respectively, wherein a

location on said tablet of the mnemonic object is coupled to a current one of said Internet-associated computer data addresses; and
accessing any specific one of said plurality of the Internet-associated computer data addresses by selecting the mnemonic object associated therewith.

9. The method as set forth in claim 8 comprising:

predefining specific locations on said tablet with data indexing functions.

10. The method as set forth in claim 9 comprising:

erasing each said mnemonic object for disassociating a location from the current one of said computer data addresses associated therewith.

11. A computerized method comprising:

accessing an internet site; and

associating an address of the site with a writable-erasable mnemonic device in a computer writing tablet such that said site is re-accessible directly from said writable-erasable mnemonic device.

12. The method as set forth in claim 11 comprising:

providing writing table function keys associated with writing-erasing a mnemonic device on said computer writing tablet.

13. The method as set forth in claim 11 comprising:

providing predetermined coordinate regions of the writing tablet such that each said mnemonic device is automatically associated with one of said predetermined coordinate regions when entered therein.

14. The method as set forth in claim 11 comprising:

automatically alternating access between a plurality of addresses accessed and associated with mnemonic devices by alternating current selection between said mnemonic devices with a writing tablet writing instrument.

15. A computer memory comprising:

computer code for recording temporary symbols associated with an Internet site address;

computer code associating the internet site address with a writable-erasable mnemonic device in a computer writing tablet for receiving said temporary symbols;
and

computer code for accessing said Internet site address via said temporary symbols.

16. (canceled)

17. An internet search tool comprising;

an internet access device;

in communication with the internet access device, a writing tablet and associated inking stylus; and

associated with the combination of internet access device, writing tablet and stylus, program code using said tablet for generating bookmarks thereon related to respective search resultant internet sites such that said sites are accessible directly via said bookmarks.

18. The tool as set forth in claim 17 wherein each of said bookmarks is a handwritten mnemonics associated with a internet site address.

19. The tool as set forth in claim 17 wherein each of said bookmarks is a temporary representation of coordinates on said writing tablet.

20. The tool as set forth in claim 19 wherein each of said bookmarks activates a jump from a current internet site address to an internet site associated with another selected one of said bookmarks.